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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 16

Application Number: 09/781,582

Filing Date: February 12, 2001

Appellant(s): REBHORN ET AL.

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Timothy Czaja  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 2, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-18 and 48 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Appellant's brief includes a statement that claim 47 and claims 1-18 and 48 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The rejection of claims 19-21 and 49 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 22-26 and 30-34 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Appellant's brief includes a statement that claims 27-29 and 22-26, 30-34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The rejection of claims 35-37,50,51 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 38-40,42, and 44-46 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Appellant's brief includes a statement that claim 41 and claims 38-40,42, and 44-46 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 43 and claims 38-40,42, and 44-46 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

|              |          |         |
|--------------|----------|---------|
| US 1,363,064 | Stegath  | 12-1920 |
| US 5,588,561 | Ness     | 12-1996 |
| US 5,753,289 | Ness     | 5-1998  |
| US 4,148,417 | Simmons  | 4-1979  |
| US 5,735,477 | Binter   | 4-1998  |
| US 5,727,679 | Newarski | 3-1998  |
| US 2,170,311 | Smith    | 8-1939  |
| US 2,026,449 | Ward     | 12-1935 |

**(10) *Grounds of Rejection***

The rejection of claims 1-9, 16,47, and 48 made under 35 U.S.C. 102 (b) as being anticipated by Davis (US 2,826,338) and the rejection of claims 1-5,7-12,16-17,47,48 made under 35 U.S.C. 102 (b) as being anticipated by Jaarsma (US 4,277,000) of Paper No. 9 are viewed as cumulative and are hereby withdrawn.

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,4-9,13, 16, and 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stegath (US 1363064). See Figures, Page 1, lines 56-101.

Claims 1-12, 16,17,19,48 are rejected under 35 U.S.C. 102(b) as being anticipated by Ness (US 5588561)

Regarding claim 1-12, Ness '561 teaches first and second, side by side compartments (items 16,18, respectively of Figure 3), each with an interior and exterior surface, abutting interior surfaces as recited in claim 2, compartments that are relatively planar, as recited in claim 3, and a have a tapered neck (i.e. the sloped portion of the container between an outer wall 12 to the threading of 24 in Figure 3) that leads to an arcuate convex spout for the first compartment (upper section of 16) and an arcuate concave mouth for the second compartment (upper section of 18), wherein both the mouth and spout have an internal surface (i.e. along threaded portion 24 and fitting portion 15 of wall 17 in Figure 3) , a cross-sectional area less than the maximum cross-sectional area of the compartment (i.e. the opening of items 16 and 18 taper at thread 24 in Figure 3),and are both aligned with interior surfaces but offset with the exterior surfaces (See figure 3)as recited in claims 4-9, and the concave mouth abuts and wraps around the convex spout as recited in claims 1,10-12 (Figure 3, Column 4, line 55 to Column 5, line 2).

Regarding claims 16,17, and 48 Ness '561 alternatively teaches a cap that selectively encompasses seals the mouth and spout together (Feature 30 of Cap 10 of Figure 1 seals both), and the complete removal of the cap (i.e. lifting and removing the feature 30 from the mouth 27) is required to expose the opening.

Regarding claim 19, Ness '561 teaches two consumable products, each within a compartment, a first compartment (item 16 of Figure 3) with an upper tapering to form a

spout (i.e. the sloped portion of the container between an outer wall 12 to the threading of 24 in Figure 3), and second compartment (item 18 of Figure 3) which may be formed separate of the first compartment (Column 5, lines 50-58) with a tapering upper portion to form a mouth (i.e. the sloped portion of the container between an outer wall 12 to the threading of 24 in Figure 3), wherein the compartments are side by side such that the mouth abuts the spot and the consumable products are contained separately (Figure 3, Column 4, line 55 to Column 5, line 2, Column 5, lines 50-67):

Claims 1-9, 16-18, 47,48 are rejected under 35 U.S.C. 102(b) as being anticipated by Ness (US 5753289).

Regarding claims 1-9 and 18, Ness '289 teaches side by side first milk compartment (i.e. item 18) and second cereal compartment (i.e. item 16), as recited in claim 18, that are relatively planar, as recited in claim 3, with abutting interior surfaces, as recited in claim 2, and each has a tapered neck (i.e. the sloped portion of the container between an outer wall 12 to the threading of 24 in Figure 3) that leads to an arcuate spout for the first compartment (upper section of 18) that abuts an arcuate mouth for the second compartment (upper section of 16), wherein both the mouth and spout have an internal surface (i.e. along threaded portion 24 and fitting portion 15 of wall 17), a cross-sectional area less than the maximum cross-sectional area of the compartment (i.e. the opening of items 16 and 18 taper at thread 24 in Figure 3), and are aligned with interior surfaces but offset with the exterior surfaces (See figure 3) as recited in claims 1,4-9 (Figure 3, Column 4, lines 8-39, 53-67).

Regarding claims 16,17, and 48 Ness '289 alternatively teaches a cap that selectively encompasses seals the mouth and spout together (Feature 30 of Cap 10 of Figure 1 seals both), and the complete removal of the cap (i.e. lifting and removing the feature 30 from the mouth 27) is required to expose the opening.

Regarding claim 47, the radius of the spout internal surface is less than the radius of the mouth (See Figure 3).

Claims 38-40,42, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Ness (US 5753289).

Regarding claims 38,40,42, and 46,Ness '289 teaches providing a first compartment (item 88 of Figure 6) tapering at an upper portion to form a spout, providing a second compartment (item 86 of Figure 6) that are configured for side by side assembly wherein the mouth and spout form a pour region that is generally centered, as recited in claim 46 (See Figure 6). Ness '289 teaches covering the spout separate from covering the mouth (Column 5, lines 10-29). Ness '289 teaches dispensing the first compartment with milk and the second with cereal, as recited in claim 42, *followed by* assembling the compartments to one another, as recited in claim 40 (Column 5, lines 49-60), such that the mouth abuts the spout (See Figure 6), as recited in claim 38

Regarding claim 39, Ness '289 alternatively teaches an assembled container that is filled in summarizing the invention (Column 1, lines 55-65).

Claims 38,44,45,46 are rejected under 35 U.S.C. 102(b) as being anticipated by Simmons (US 4148417) as evident by Binter (US 5735422).

Regarding claim 38, Simmons teaches providing a fist and second compartment, assembled side-by side, each tapering at an upper portion to respectively form a spout and mouth, which abut each other, and covering the mouth and covering the spout.

Simmons further teaches discharging the consumables from the compartments. (See Figure 2, Column 2, line 45 to Column 3, 39, Column 1, lines 1-19). Simmons teaches covering the mouth and spout can be done together or separately (see Figures).

Simmons inherently teaches filling dispensing a first consumable *into* a first compartment and second consumable *into* a second compartment since Simmons teaches dispensing a first consumable *out of* a first compartment and second consumable *out of* a second compartment. Without dispensing consumables into the compartments Simmons could not have dispensed the consumables from the compartments, as evident by Binter who also teaches molded plastic dispensing containers comprising two separate compartments, the first component is dispensed into the first compartment and the second component is dispensed into the second compartment (Column 1, lines 12-31, Column 3, lines 48-65)

Regarding claim 44, assembly includes a shrink label (Column 4, lines 14-24).

Regarding claim 45, Simmons teaches covering the second compartment includes selectively securing a cap over the mouth and spouts since the cap (item 57 in figure 2) comprises covering for both mouth and spout.

Regarding claim 46, Simmons teaches the spout and mouth pour region substantially centered (Figure 2).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) as applied to claims 1-9, 16-18, 47,48 above further in view of Newarski (US5727679).

Ness is silent in teaching a membrane over the spout. However, Newarski who also teaches assembled two compartment containers holding milk and cereal is relied on as evidence of the conventionality of a using a membrane barrier with the milk compartment (Column 3, lines 14-33). Therefore it would have been obvious to include a membrane on the spout since one would have been substituting one milk compartment package feature for another for the same purpose: provide assembled cereal and milk compartments.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) as applied to claims 1-9, 16-18, 47,48 above further in view of Simmons (US 4148417).

Regarding claim 14, Ness '289 teaches attaching two separate consumable products in side-by-side compartments, but is silent in teaching using a film wrap. However, Simmons, who also teaches separate consumable product compartments attached in a side-by-side manner (See Figure 2, Column 1, lines 1-31, Column 2, line 45 to Column 3, line 37), is relied on as evidence of using film wrap to attach the two compartments (Column 4, lines 3-13). Therefore, it would have been obvious to modify

Ness '289 and use a film wrap to secure the compartments to one another since one would have been substituting one means for attaching compartments for another for the same purpose: two consumable product compartments in a side-to-side configuration.

Claims 19-28,32-34,49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311).

Regarding claims 19-28,32,34, Ness '289 teaches a container comprising a first milk containing compartment and a second cereal containing compartment, as recited in claims 20,21, and 34, that are side-by-side (See Figure 6), wherein the first compartment (item 86 of Figure 6) has an opening, and includes spout as recited in claim 27, (at item 96 of Figure 6) with a cross-sectional area less than the maximum cross-sectional area of the first compartment, the second compartment (item 88) has an opening, and includes a mouth as recited in claim 28 and cap as recited in claim 32,(adjacent to item 96) with a cross-sectional area less than the maximum cross-sectional area of second, and the openings are substantially centered and form a circular pour region, as recited in claims 22 -24(Figure 6, Column 5, lines 10-65). Although Ness '289 teaches the size ratio/ shape of the compartments depend on the particular type of food in the container, cleaning, insulation requirements and the intended users (Column 6, lines 21-44) and in other embodiments (e.g. figure 3) Ness '289 shows the smaller first milk compartment is concave and the larger second cereal

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compartment is convex, Ness '289 is silent in teaching that the larger cereal-containing second compartment is concave and wraps around the smaller milk-containing convex first compartment as recited in claim 22,25, and 26.

Ward, like Ness '289, also teaches a two compartment container (one convex, one concave) with consumable products that is intended for dispensing the products simultaneously into a person's mouth and is relied on as evidence of the conventionality of forming the larger compartment in a concave shape that wraps around a convex smaller compartment.

Smith is relied on as evidence of the conventionality of a cereal/milk container having a larger concave cereal section wrapping around a smaller convex milk (or cream) section (Figures, Column 1, lines 1-22).

Therefore, to modify the structure of Ness '289 such that the larger cereal-containing second compartment is concave and wraps around the smaller milk-containing convex first compartment as recited in claim 19, 22,25, and 26, would have been an obvious result effective variable of the shape and size ratio depend on the particular type of food in the container, cleanability desired, insulation requirements and the intended users since (1) Ness '289 teaches convex and concave compartment shapes and the shape and size ratio depend on the particular type of food in the container, cleanability desired, insulation requirements and (2) this was a well known compartment design for both a two compartment consumable product container, including milk and cereal containers. One would have been substituting one type of

two-compartment consumable product container having a convex and concave compartment for another for the same purpose: dispensing simultaneously.

Regarding claim 33, Ness alternatively teaches a cap that selectively encompasses seals the mouth and spout together (Feature 30 of Cap 10 of Figure 1 seals both).

Regarding claim 49, Ness teaches the openings are integrally formed with a spout and a mouth (i.e. via item 14 of Figures 1 and 3) wherein the exit from the spout defines a circle and the mouth is a non-circle (see item 14 figure 3).

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311) as applied to claims 19-28,32-34, 49 above further in view of Stegath (US 1363064)

Regarding claim 29, Ness '289 teaches a spout for a smaller compartment and mouth for a larger compartment, but is silent in teaching the spout is at a height less than the mouth. However, Stegath who also teaches two compartment containers shows a variety of positions of the spout and mouth, but when the spout is attached to a smaller compartment Stegath teaches the spout is shorter than the mouth (See Figure 1). Therefore it would have been obvious to include a spout shorter than a mouth since one would have been substituting one spout design for another for the same purpose: a two compartment container with larger compartment having a mouth and a smaller compartment having a spout.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311) as applied to claims 19-28,32-34, 49 above further in view of Simmons (US 4148417).

Regarding claim 30, Ness '289 teaches attaching two separate consumable products in side-by-side compartments, but is silent in teaching using a film wrap. However, Simmons, who also teaches separate consumable product compartments attached in a side-by-side manner (See Figure 2, Column 1, lines 1-31, Column 2, line 45 to Column 3, line 37), is relied on as evidence of using film wrap to attach the two compartments (Column 4, lines 3-13). Therefore, it would have been obvious to modify Ness '289 and use a film wrap to secure the compartments to one another since one would have been substituting one means for attaching compartments for another for the same purpose: two consumable product compartments in a side-to-side configuration.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311) as applied to claims 19-28,32-34,49 above further in view of Newarski (US5727679).

Ness is silent in teaching a membrane over the spout. However, Newarski who also teaches assembled two compartment containers holding milk and cereal is relied on as evidence of the conventionality of a using a membrane barrier with the milk compartment (Column 3, lines 14-33). Therefore it would have been obvious to include a membrane on the spout since one would have been substituting one milk

compartment package feature for another for the same purpose: provide assembled cereal and milk compartments.

Claims 35-37, 50,51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289).

Regarding claims 35-37, 50,51, Ness '289 teaches a first milk containing compartment and a second cereal containing compartment, as recited in claims 36 and 37, that are side-by-side (See Figure 6), wherein the first compartment (item 86 of Figure 6) has an opening (at item 96 of Figure 6) with a cross-sectional area less than the maximum cross-sectional area of the first compartment, the second compartment (item 88) has an opening (adjacent to item 96) with a cross-sectional area less than the maximum cross-sectional area of second, at least one compartment opening is substantially centered, as recited in claim 35 (Figure 6, Column 5, lines 10-65). Ness '289 teaches the opening of the milk compartment has a smaller cross-sectional area than the opening of the cereal compartment (In the embodiment of Figure 6 and the Embodiment shown in Figure 2) and further teaches (in the Embodiment of Figure 2) that the milk opening should be *sufficiently small* to prevent milk flowing through via gravity and the cereal opening should be *sufficiently large* to allow for cereal to flow via gravity, such an oval shaped opening of 1.5 in for the cereal and a water bottle-type Opening for the milk (Column 4, lines 18-25, Column 6, lines 13-21). However, Ness '289 is silent in teaching the cereal opening is at least 3 times greater in size per se, as recited in claim 35, or 4 or 5 times greater as recited in claims 50 and 51. Because

Ness '289 teaches the milk opening should be *sufficiently small* to prevent milk flowing through via gravity and the cereal opening should be *sufficiently large* to allow for cereal to flow via gravity, to select a cereal opening at any particular size such as 3,4, or even 5 times greater in size than the liquid opening would have been an obvious result effective variable of the size of cereal and the size of cereal opening required to allow cereal to flow via gravity. Large cereal forms such as flakes, granola clusters, cereals comprising dried cranberries and almonds, etc. Would obviously require a larger opening to flow via gravity than a smaller granule-type cereal (e.g. Grape-Nuts ®).

Claims 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) as applied to claims 38-40,42, and 46 above, further in view of Newarski (US5727679).

Although Ness '289 teaches milk can be dispensed into one compartment and refrigerated until use and cereal can be supplied in the other compartment and stored on a shelf until use. Ness teaches dispensing is carried out by the consumer at home (Column 4, lines 53-67). Ness '289 is silent teaching aseptically sterilizing the milk before dispensing , as recited in claim 41 and dispensing in an aseptically sterilized environment as recited in claim 43

Newarski also teaches assembled two attached compartment containers holding milk and cereal, which may be stored separately or together. Newarski, however, teaches milk compartments are known to be either refrigerated, like Ness '289, or aseptically packaged so that the milk compartment can be stored with the cereal

compartment (Column 1, lines 13-47). Thus, Newarski is relied on as evidence of the conventionality of aseptically sterilizing the milk, which would involve discharging in an aseptically sterilized environment as known in commercial preparation of aseptically packaged milk, so that liquid milk compartment can be conveniently stored along with the cereal compartment (Abstract, Column 1, line 50 to Column 2, line30, Column 3, lines 1-33). Therefore, to include an aseptically sterilizing step would have been an obvious result effective variable of the type of storage desired since Newarski teaches that milk dispensed into a compartment for refrigeration must be stored separately from the cereal department whereas milk that is aseptically sterilized and filled in an aseptically sterilized environment allows one to store the milk and cereal together in a non-refrigerated environment. Furthermore, one would have been substituting one method of dispensing milk into a compartment for another for the same purpose: provide an assembled cereal and milk compartment set.

**(11) Response to Argument**

Rejections Made Under 35 U.S.C. 102 (b)

*Argument A*

Appellant has stated the applicable law for 35 U.S.C. 102. these rejections. The examiner has responded to subsequent arguments to support inherency rejections.

*Argument B*

(Claims 1-9, 16,47, and 48 rejected under 35 U.S.C. 102 (b) by Davis (US 2,826,338)

This argument is moot since the rejection has been withdrawn.

*Argument C*

(Claims 1,4-9,13,16, 48 rejected under 35 U.S.C. 102(b) by Stegath (US 1,363,064))

Appellant argues that the container of Stegath, since Stegath includes items such as lotion and shaving cream, the mixing of the two preparations would be undesirable. However Appellant is reminded this feature of "mixing" the contents of both compartments is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Appellant is reminded that the *intended* use of the claimed invention must result in a *structural* difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Appellant further argues that Stegath depicts embodiments that show openings that do not meet the limitation of claim 1 "such that the mouth abuts the spout". As clearly viewed in Figures 1 and 3 of Stegath, there are two side-by-side compartments (e.g. items 1 and 3) having tapering upper sections forming a mouth and a spout, wherein the exteriors of both have different radii, and the mouth *abuts* the spout. Appellant has defined the abutment of the mouth and spout as follows:

"The first and second compartments are assembled to one another in a side-by-side fashion such that the spout abuts the mouth. With this configuration, during use, a first consumable product and a second consumable product can be dispensed from the container in close proximity to one another for convenient consumption." (See Page 3, lines 18-21)

Therefore, since Stegath unmistakably shows in Figures 1 and 3 that (1) the compartments are in a side-by-side fashion and (2) the products can be dispensed within close proximity, Stegath teaches the mouth abuts the spout.

#### *Argument D*

(Claims 1-5,7-12,16-17,47,48 rejected under 35 U.S.C. 102(b) by Jaarsma (US 4277000).

This argument is moot since the rejection has been withdrawn.

#### *Argument E*

(Claims 1-12,16-19,47 and 48 rejected fewer than 35 U.S.C. 102(b) by Ness (US 5588561) and Ness (US 5753289).

Appellant argues that the Ness patents do not "taper at an upper portion thereof to form a spout" and require a lid to regulate or control flow from the compartments.

However, as provided in Appendix B of the Brief, Ness teaches a taper at an upper portion (i.e. the opening of items 16 and 18 taper at thread 24). Thus, Appellant has not defined "spout" in such a way in claim 1 that would exclude the tapered section of Ness from being a spout.

Appellant further argues that the Ness patents require a lid to regulate flow. Appellant is reminded that the *intended* use of the claimed invention must result in a *structural* difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Appellant further argues that the openings of both compartments have identical radii along their exterior sections. Claim 1 recites: a spout forming a passage along a spout internal surface, a mouth forming an opening along a mouth internal surface, and the spout and mouth are positioned such that each of the respective internal surfaces define an internal section and an external section. Claim 1 does not define the exterior section as the section forming an external surface of the *container*, as implied by Appellant. Rather the exterior section of the mouth or spout is merely outside of the internal surfaces of the mouth and spout. In the case of Ness, Figure 3, for example, the convex perspective of wall 17 serves as an external section to the inner surface of the upper tapering section of compartment 16. As such, the radius the external portion of the inner surface of the upper tapering section of compartment 16 along wall 17 would indeed be different from the radius external section of the inner surface of the

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upper tapering section of compartment 18 that forms an exterior surface of the container.

*Argument F*

(Claims 38-40,42, and 46 rejected under 35 U.S.C. 102(b) by Ness (US 5588561) and Ness (US 5753289).

Appellant argues that Ness fails to teach forming a spout with respect to Figure 3. The argument is moot because the examiner did not rely on the embodiment of Figure 3 in the rejection. The rejection was based on the embodiment of Figure 6.

With respect to Appellant's argument that Figure 6 teaches a non-separable embodiment and does not disclose "assembly of the first and second compartments to one another". The embodiment of Ness depicted in Figure 6 does provide for "assembly of the first and second compartments to one another". As cited in Paper No. 9, Column 5, lines 49-60 in Ness describes compartments that are assembled to one another.

With respect to Appellant's argument that Ness does not teach a separate lid or cover (in light of cover 50 of Ness), Appellant's argument is moot because the arguments do not address the rejection set forth in Paper No.9. and are directed to embodiments of Ness that are not relied on in the rejection. The embodiment relied on in the rejection (i.e. Figure 6) , includes covering the spout separately from covering mouth (i.e. a drip free spout, item 96, is used to seal compartment 86 and a cap, not

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shown, is provided to seal 88), and Paper No. 9 directed Appellant's attention to Column 5, lines 10-29 for this embodiment.

*Argument G*

(Claims 38,44,45,46 rejected under 35 U.S.C. 102(b) by Simmons (US 4148417) as evident by Binter (US 5735422). )

Appellant argues Simmons does not teach the combination of the mouth and spout abutting and having separate covers. As noted in Paper No. 9, Appellant is directed to the Figures of Simmons to show how the mouth and spout are either sealed together or separately. In particular , the embodiment of Figure 2 was cited, including Column 2, line 45 to Column 3, line 39. Looking at Figure 2, where the spout and mouth abut, as admitted by Appellant, the mouth and spout are separately sealed since clearly one cover (e.g. 59a) remains closed, while the other cover (e.g. 60a) remains open.

Appellant argues that Simmons does not teach "assembling" the compartments to one another. Again, as cited in Paper No. 9, Appellant's attention was directed to Column 2, line 45 to Column 3, line 39. Specifically, lines 24-35 of Column 3 state that a further embodiment may comprise two separate halves, each with a flat side, wherein "the two halves are assembled with their planar surfaces in registry and secured to each other by suitable adhesive."

Rejections Made Under 35 U.S.C. 103(a)

*Argument A*

Appellant has state the applicable law for rejections made under 35 U.S.C. 103.

Examiner has responded to the subsequent arguments of non-obviousness.

*Argument B*

(Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Simmons (US 4148417))

Appellant has argued claim 14 individually, but has stated that claim 14 shall stand or fall with the patentability of claim 1 (See Group I of Grouping of the Claims). Appellant argues that since Simmons was not applied in the rejection of independent claim 1, Simmons cannot be used to establish a *prima facie* case of obviousness, as applied to the rejection of dependent claim 14. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, which Appellant has not addressed. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As noted in Paper No. 9, Simmons was relied on as teaching a means for attaching containers in a side-by-side relation. Simmons teaches separate consumable product compartments attached in a side-by-side manner (Appellant's attention was directed to Figure 2, Column 1, lines 1-31, Column 2, line 45 to Column 3, line 37) and Appellant's attention was further directed to Column 4, lines

3-13 wherein Simmons teaches using film wrap to attach two independently molded containers.

*Argument C*

(Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Newarski (US5727679))

Appellant has argued claim 15 individually, but has stated that claim 14 shall stand or fall with the patentability of claim 1 (See Group I of Grouping of the Claims). Appellant argues that claim 1 is not anticipated Ness, because fails to suggest a spout and mouth having differing radii, and thus Newarski fails to alter this analysis. However, as discussed above under Rejections Made Under 35 USC 102, Figure 3 of Ness teaches the convex perspective of wall 17 serves as an external section to the inner surface of the upper tapering section of compartment 16. As such, the radius of the external portion of the inner surface of the upper tapering section of compartment 16 along wall 17 would indeed be different from the radius of the external section of the inner surface of the upper tapering section of compartment 18 that forms an exterior surface of the container. As Ness is silent in teaching a membrane over the spout, Newarski, who also teaches assembled two compartment containers holding milk and cereal, is teaches using a membrane barrier to seal the milk compartment (Column 3, lines 14-33). Thus, Newarski suggests a membrane to seal the milk spout of Ness, which has a radius different from the radius of the mouth.

*Argument D*

(Claims 19-21,49 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311)).

Appellant asserts that Ness does not teach tapering at an upper portion of a compartment to form a spout. The rejection applied to claims 19-28,32-34,49 in Paper No. 9 relied on the embodiment of Figure 6 ,Column 5, lines 10-65, and column 6 lines 21-44. Figure 6 has a container 80, and *not* a container 10, as discussed by Appellant. Ness teaches a tapering at an upper portion to form a drip free spout in Figure 6 (i.e. item 96 of Figure 6 as defined in Column 5, lines 25 and 26).

Appellant further asserts that Ness does not teach a "separate compartment" embodiment in combination with curved interior walls. As noted above, the rejection applied to claims 19-28,32-34,49 in Paper No. 9 relied on the embodiment of Figure 6. After discussing the embodiment of Figure 6, Ness teaches:

"the preferred divided compartment cup has two enclosed and separate compartments. Basically, these compartments can be partial halves or semi-circle cylinders that run from the bottom to the top of the base unit." (Column 5, lines 30-33).

"Of course, the shape of each compartment can vary according to the teaching of the invention to accommodate the desired configuration" (Column 5, lines 35-37)

"the milk and cereal compartments may be constructed as individual pieces. These pieces would be designed to be interlocking which slide together and "snap" in place;" (Column 5, lines 49-52).

It is noted that Ness does not exclude the inner wall from being curved, limit the inner wall to any particular shape, or restrict these "snap" in place feature to any particular embodiment. As such, these statements are taken to be applicable to all of the embodiments of Ness. Examiner did note in Paper No. 9 that Ness includes concave/convex sections in specific embodiments other than Figure 6.

In response to Appellant's argument that Ward and Smith cannot possibly provide motivation for modifying the shape of the Ness compartments because neither teach a spout or mouth, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Ward and Smith are relied as evidence of the shape selected for the compartments in a consumable product container. Both teach two-compartment consumable product container, wherein Ward teaches a larger concave compartment and a smaller, adjacent convex compartment for dispensing into a person's mouth and Smith (in the Figures and Column 1, lines 1-22) teaches a milk/cereal container wherein the milk, or cream, portion is a smaller convex portion. Thus, both suggest an alternative design to Ness for the same purpose: two compartment consumable product containers used to dispense the contents therein simultaneously.

#### *Argument E*

(Claims 22-28,32-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311)).

As discussed in response to *Argument D* above and contrary to Appellant's assertion, the examiner referenced the embodiment of Figure 6 , Column 5, lines 10-65

, and Column 6, lines 21-44 of Ness in the rejection of claims 22-28 and 32-34. As such compartments 86 and 88, were cited *not* compartments 16 and 18, as discussed in Appellant's arguments.

In response to Appellant's argument that Ward and Smith cannot possibly provide motivation for modifying the shape of the Ness compartments, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, Ness teaches:

Of course, the shape of each compartment can vary according to the teaching of the invention to accommodate the desired configuration" (Column 5, lines 35-37)

The portable food container can accommodate several sizes and several different configurations which are within the scope of the present invention...The configuration of the cup can be altered by compartment arrangement so as to provide different size and shape compartments. The shape of each compartment can be altered to provide increased insulation and/or to provide a surface which is easier to clean (Column 6, lines 22-31)

Ward and Smith are relied as evidence of the shape selected for the compartments in a consumable product container. Both teach two-compartment consumable product container, wherein Ward teaches a larger concave compartment and a smaller, adjacent convex compartment for dispensing into a person's mouth and Smith (in the Figures and Column 1, lines 1-22) teaches a milk/cereal container wherein the milk, or cream, portion is a smaller convex portion. Thus, both suggest an alternative design to

Ness for the same purpose: two compartment consumable product containers used to dispense the contents therein simultaneously.

Appellant asserts that Ness does not a spout, as recited in claim 27. However, as noted previously, the rejection of claim 27 was based on the embodiment of Figure 6 which teaches, a tapering at an upper portion to form a drip free spout in Figure 6 (i.e. item 96 of Figure 6 as defined in Column 5, lines 25 and 26).

*Argument F*

(Claim 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311), further in view of Stegath (US 1363064)).

Appellant argues that the rejection of claim 29 is flawed because Ness in view of Ward and Smith do not teach the features of claim 22, from which 29 depends. However, as discussed with respect to Argument E above, Ness in view of Ward and Smith do teach the features of claim 22, including a spout for a smaller compartment. Stegath teaches a the spout for a smaller compartment may be shorter than the mouth in a two compartment container, and it would have been a substitution of spout designs for the same type of containers (i.e. attached containers with small and large compartments)

*Argument G*

(Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311) further in view of Simmons (US 4148417).)

Appellant has stated that claims 22-26 and 30-34 stand or fall with the patentability of claim 22, which was discussed in Argument E above. Appellant further argues that the rejection of claim 30 is flawed because Ness in view of Ward and Smith do not teach the features of claim 22, from which 30 depends. As discussed with respect to Argument E above, Ness in view of Ward and Smith do teach the features of

claim 22 and Ness also teaches the separate compartments may be secured together. Simmons teaches a film wrap as a means for securing two compartments holding consumable products , and thus teaches an securing means equivalent for the same purpose: attaching two consumable product containers together in a side-by-side configuration.

*Argument H*

(Claim 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) in view of Ward (US 2026449) and Smith (US 2170311) further in view of Newarski (US5727679)).

Appellant has stated that claims 22-26 and 30-34 stand or fall with the patentability of claim 22, which was discussed in Argument E above. Appellant argues that Ness does not suggest a design modification to the divider wall 17, with respect to claim 22 from which 31 depends. However, as discussed with respect to the preceding arguments, the embodiment relied on for the rejection of claim 22 and 31 in Paper No. 9 was Figure 6 of Ness, which did not include divider wall 17, but a wall 94. Furthermore, Ness teaches milk and cereal. Newarski also teaches assembled two compartment containers holding milk and cereal, and Newarski uses a membrane barrier with the milk compartment (Column 3, lines 14-33). Thus to include the membrane would have been substitution of conventional seals for the same purpose: connected and separately sealed cereal and milk compartments.

*Argument I*

(Claims 35-37, 50,51 rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289))

Appellant argues that Ness (in the embodiment of Figure 6) has two compartments that have relatively the same cross-section and that neither opening is substantially centered. However, as discussed in Paper No. 9, the examiner refers to the "opening" of the first compartment "at item 96 of Figure 6" has a cross-sectional area less than the maximum of the second opening, wherein the second compartment opening is "adjacent to item 96", which, as stated in Paper No. 9. Additionally, as shown in Figure 6, both openings are substantially centered.

Appellant further argues that Ness requires an additional lid 84 (in the embodiment of Figure 6) to control product dispersion and that the openings are not to be considered at the lid portion as defined by the examiner. First, in response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the feature upon which Appellant relies (i.e. means for controlling product dispersion) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, there is no limitation in the claim 35 that would exclude a compartment formed by two integral pieces. Third, Ness defines the container 80 as a lid 84 plus a body 82 (Column 5, lines 10-14), and lid 84 and body 82 meet the

limitations of the claim in that they are compartmented and form openings of different cross-sections.

Appellant further argues that Ness teaches away from smaller openings for each compartment because it would render the compartments virtually impossible to clean. However, claim 35 does not limit the size of any opening such that one would expect that the openings to be too small to clean. Additionally, as shown in Figure 6, the opening of one compartment is indeed smaller than the opening of the other (i.e. see the openings "at item 96 of Figure 6" and "adjacent to item 96").

#### *Argument J*

(Claims 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ness (US 5753289) further in view of Newarski (US5727679))

Appellant argues Ness fails to meet the limitations of claim 38, from which 41 and 43 depend. Appellant argues that neither Newarski , nor Ness, teach compartments that taper to form a mouth or spout , covering the mouth, and sealing the spout. However, as discussed in Argument F (Rejections Made Under 35 USC 102), the embodiment relied on in the rejection (i.e. Figure 6). Ness teaches the container comprises a lid 84 plus a body 82 and a covering over the spout separately from covering mouth (i.e. a drip free spout, item 96, is used to seal compartment 86 and a cap, not shown, is provided to seal 88).

Appellant further argues that since Ness teaches a container that is filled by the consumer, Ness teaches away from aseptically filling, as recited in claims 41 and 43.

In response to Appellant's argument that there is no suggestion to combine the Ness with Newarski, who teaches aseptic filling, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as discussed in Paper No. 9 Ness teaches in Column 4, lines 53-67, that the milk portion is refrigerated and stored separately from the cereal. Newarski, as noted in Paper No. 9, recognizes it is known to refrigerate the milk separately from the cereal, in Column 1, lines 13-47, and teaches that milk may also be aseptically sterilized so both milk and cereal can be conveniently stored together. Thus, Newarski teaches an alternate step for packaging milk for a milk and cereal together: aseptic packaging. As noted in Paper No. 9, even though aseptic packaging is a known commercial preparation, rather than a consumer preparation, Newarski does provide motivation for selecting this alternate step : one is able to store both milk and cereal compartments together.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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